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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,422	12/06/2001	Ashok Kumar Shukla		5421

7590 07/23/2003
ASHOK KUMAR SHUKLA
10316 KINGSWAY COURT
ELLICOTT CITY, MD 21042

EXAMINER

RAEVIS, ROBERT R

ART UNIT PAPER NUMBER

2856

DATE MAILED: 07/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/003,422

Applicant(s)

SHUKLA ET AL.

Examin r

Robert R. Raevis

Art Unit

2856

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other.

DETAILED ACTION

1. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 1 and 2; is "containing" (line 1) correct? After all, it would appear that some of the magnets (in Applicant's drawings) contain the pipette.

As to claims 9 and 17; "methods," (line 2 from last) is confusing, as no method is described.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 4, 5, 7-11, 12, 13, 14, 16-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Suovaniemi et al.

Suovaniemi et al teach a pipetting device that contains an electric motor 9, the motor of which includes both magnetic material and magnet.

As to claims 1, 4, 5, 7-9, 2, 13, 14, 16, 17, 20; the phrase "to attach ...force" (lines 1-3) is a statement of intended use, and thus does not serve as a structural limitation that weight may be given to. After all, the claim is expressly directed to a "pipetting device", and the *claimed* device does *not* include structure to which the device is connected to. The claim is not directed to a pipetting device that is connected to a second body via a magnet, collectively being a combination pipette and second body.

As to claims 10, 11, 18, 19; the motor with gearing is within housing structure, suggestive of permanence, but is reversible when under construction.

5. Claims 1, 3-10, 2, 12-18 and 20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Moriarty.

Moriarty teaches a pipetting assembly, that includes a pipette secured to a hanger, the hanger of which contains a magnet for attaching the assembly by means of a magnetic force.

As to claims 1, 3-5, 7-9, 2, 12-14, 16, 17, 20; the pipette is secured to the hanger, and together provide for a (single) device.

As to claims 6, 15; note that portion 30 appears to be an arm, and that use of plastic is a common support structure suggestive that Moriarty's ^{arm} ~~are~~ is plastic.

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As to claims 10, 18; note that the magnet is glued (col. 5, line 27).

6. Claims 11 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moriarty in view of Taylor.

As to claims 11 and 20; it would have been obvious to employ a reversible connection because Taylor teaches use of mechanical connections (element 3, along with screws that are visible in Figure 1) to secure a magnet to an item to be fixed.

7. Claims 2, 12-17 and 20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Janchen.

Janchen teaches a pipette 7 with iron core 9, the core 9 responding to a magnet 5 that holds the pipette.

As to claim 2, 12-14, 16, 17 and 20; the pipette appear to contain the core.

As to claim 15; note arm 3.

8. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janchen.

As to claims 18 and 19, the reference does not describe how the core 9 is attached to the pipette, but it is known to attach elements via adhesive, some of which are permanent and others removable.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tucker et al teach connecting a magnet 15 to a device that is to be magnetically secured to a body.

Hempel and Won teach mounting a magnet to a holder to secure a device.

Fielden et al, Ghazizadel and Tesmer teach flexible holders.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert R. Raevis whose telephone number is 703-305-

flexible
touch screen
phone.

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4919. The examiner can normally be reached on Monday to Friday from 6:30am to 4:00pm. The fax phone number for the organization where this application or proceeding is assigned is 703-308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4900.

R. O. W.
AU 2856
RAEVIS